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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
BELIVEAU, SCOTT E	

ART UNIT	PAPER NUMBER
2614	18

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/590,434	JERDING ET AL.	
	Examiner	Art Unit	
	Scott Beliveau	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *72-108* is/are pending in the application.

4a) Of the above claim(s) *72-95 and 105-108* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *96-104* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 72-95 and 105-108 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Originally elected claims 6-15, and 22 were directed to a method for an interactive media guide with promotional/preview functionality. For example, claims 6-8 were related to purchasing presentations subsequent to watching a movie trailer in conjunction with a promotional channel, claims 9-12 were directed towards the retrieval of additional information such as a preview or a trailer related to a program of interest, claims 13-15 were directed towards the insertion of promotional material in association with a requested presentation (IA: Page 25, Lines 10-19), and claim 22 was directed towards a method for viewing a preview via an interactive media guide and subsequently facilitating the ordering of that program. These claims were generally classified in class 725, subclass 8. Newly submitted claims 72-95 and 105-108 are directed towards a method and apparatus for suspending the presentation of a motion video presentation and subsequently providing a promotional motion video presentation as a result of a user's inactivity. As set forth in the specification, this embodiment is directed towards the screen-saver functionality (Page 28, Line 31 – Page 29, Line 2; Page 29, Line 36 – Page 30, Line 9). None of the originally elected claims pertain to the control of the playback of presentation wherein promotional information is displayed in association with the suspension of the media presentation. Furthermore, the subject matter pertaining to an interactive media guide which services as a screen saver utility for which the claims are directed was not elected as noted in Paper 11.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 72-95 and 105-108 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

With respect to newly presented claims 96-104, the claims appear to be directed towards the ability to display custom advertisements in conjunction with the display interface (IA: Page 33, Lines 28 – Page 34 Line 23). The claims, as presented, however, are not limiting with respect to when the promotional media or merchandise advertising data can be presented. Accordingly, claims 96-104 are interpreted as being patentably indistinct from originally elected claims 13-15 and an action on claims 96-104 follows.

Priority

2. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 96-104 of this application. In particular, the examiner cannot find support for the "receiving merchandise advertising data associated with a plurality of motion video presentations" and "receiving said one of the plurality of motion video presentations over the dedicated network session". The provisional application makes references to a similar architecture as that utilized by the instant application, however, there does not appear to be an enabling disclosure pertaining to the particular usage of such in conjunction with the delivery of merchandise advertising data as particularly claimed.

While the examiner has made every effort in reviewing the provisional application for support under 35 U.S.C. 112, given the size of the provisional application and lack of a clear correspondence between it and the instant application, information within the provisional application may have been overlooked. If the applicant believes that the examiner has overlooked such support/subject matter, it is requested that the applicant reference this subject matter by page number in response to this Office Action so that the examiner may quickly locate and evaluate the applicant's remarks in view of the provisional application.

Drawings

3. The drawings were received on 23 March 2004. These drawings are approved with respect to newly submitted Figure 19C.

Response to Arguments

4. Applicant's arguments with respect to claims 43-71 have been considered but are moot in view of the new ground(s) of rejection necessitated as applicant has cancelled all previously presented claims.

Claim Objections

5. Claim 96 is objected to because of the following informalities:

- The "receive user input corresponding to one for the plurality of motion video presentations" should be amended to read "receive user input corresponding to one <u>of</u> [for] the plurality of motion video presentations";

- The term "sever" should be amended to read "server".

Appropriate correction is required.

6. Claim 99 is objected to because the phrase "said one for the plurality of motion video presentations" should be amended to read "said one of [for] the plurality of motion video presentations". Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 103 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the reference discloses that the "first communication channel" utilizes QPSK (as opposed to the claimed QAM) and the "second communication channel" utilizes QAM (IA: Page 6, Lines 14-16).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 96-102 are rejected under 35 U.S.C. 102(e) as being anticipated by White et al. (US Pat No. 6,628,302).

In consideration of claim 96, as illustrated in conjunction with 1, the White et al. embodiment the reference discloses a "set-top terminal (STT)" [14] coupled to a "server" [12] via a "bi-directional communication network" [16]. The "set-top terminal" [14] comprises a "memory having program code stored therein" [40/42] (Col 3, Lines 1-8) and at least "one processor that is programmed by the program code to enable the STT" [38] (Col 2, Lines 63-67). The terminal is subsequently operable to "receive merchandise advertising data" [72] associated with a "plurality of motion video presentation" and to "provide the merchandise advertising data to a user via a television signal" (Figure 4; Col 4, Lines 12-22). Subsequently, the embodiment is operable to "receive user input corresponding to one of the plurality of motion video presentations" (Col 4, Lines 23-38), "establish a dedicated network session with the server for receiving said one of the plurality of motion video presentations", "receive said one of the plurality of motion video presentations over the dedicated network session" and to "provide said one of the plurality of motion video presentations to the user" (Col 4, Lines 38-64; Col 5, Lines 33-58)

Claim 97 is rejected wherein the "merchandise advertising data comprises graphics" [72] (Figure 4).

Claim 98 is rejected wherein the "merchandise advertising data" [72] corresponds to "merchandise being provided by an entity other than an entity that is providing the motion

video presentation" wherein the advertised soft-drink Coke™ is not provided by the broadcast provider.

Claim 99 is rejected wherein the "at least one processor . . . enables trick-mode functionality to be implemented in connection with said one of the plurality of motion video presentations" (Figure 5).

Claims 100 and 102 are rejected wherein the White et al. reference discloses that the "merchandise advertising data" [70] associated with HTML primitives delivered via the network [16] is modulated "received over a first communication channel" and the "motion video presentation" is "received over a second communication channel that is different from said first communication channel" such that each is associated with a different "radio-frequency channel having a specified center frequency" in the case of digital video distribution (Col 2, Lines 37-46, 49-52).

Claim 101 is rejected wherein the "first and second communication channels correspond to a same type of communication channel" wherein both channels are of a type that distributes video information to the subscriber.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claim 103 is rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US Pat No. 6,628,302).

In consideration of claim 103, the White et al. reference discloses that the aforementioned "first and second communication channels" are modulated [34] (Col 2, Lines 37-46), however, the reference does not explicitly disclose the particular type of digital modulation. The particular usage of QAM as a modulation technique is well known in the art of video distribution (ex. Adams et al.: Col 2, Lines 41-44). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize QAM as a modulation technique for the purpose of using a digital modulation technique that facilitates the transmission of more data within the same RF bandwidth than BPSK or QPSK.

14. Claim 104 is rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US Pat No. 6,628,302), in view of Wang (US Pat No. 6,675,385).

The White et al. reference does not explicitly disclose nor preclude the particular distribution of the "merchandise advertising data" associated with the HTML based user interface via the "broadcast file system" [30] in a "cyclical" manner. The Wang reference

discloses a method for distributing an HTML interface using a carousel or "cyclically" (Col 2, Lines 9-50). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the "cyclical" interface distribution techniques of Wang in conjunction with the White et al. embodiment for the purpose of enabling the distribution and display of a HTML based user interface to resource-deprived set-top boxes (Wang: Col 2, Lines 50-59).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Adams (US Pat No. 6,378,130) reference discloses a media server architecture to interconnect subscriber terminals to a head-end which particularly utilizes QAM in conjunction with signal distribution.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 9:00 a.m. - 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEB
April 8, 2004

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